

REMARKS/ARGUMENTS

Claim Amendments

The Applicant has amended claim 21. Applicant respectfully submits no new matter has been added. Accordingly, claims 21-39 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

Examiner Objections - Claims

Claim 21 was objected to because of informalities. The Applicant appreciates the Examiner's thorough review of the claims. The Applicant has amended the claim in order to correct the informality. The Examiner's consideration of the amended claim 21 is respectfully requested.

Claim Rejections – 35 U.S.C. § 103 (a)

Claims 21-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,161,180 to Chavous in view of US Patent Application Publication 2001/0055299 to Kelly and further in view of US Patent 6,151,631 to Ansell et al. In response, the Applicant respectfully disagrees.

Chavous discloses a method and system for determining the location of a PBX extension phone in a PBX system. The Examiner stated Chavous generally discloses the step of translating the IP address using information retrieved from an ISP as the translation of the extension telephone number identifying the telephone into the location of the extension telephone using the interceptor's database. The Applicant respectfully disagrees with this characterization. There is considerable difference between a PBX extension and an IP address. The process of obtaining the location from a PBX extension and the process of obtaining the location from an IP address are distinct and do not translate into the same step. Additionally, the Examiner stated that the step of retrieving information associated with the IP address (equating this to an extension number) that includes a physical address and a PSAP compatible telephone number is disclosed. The Applicant also respectfully disagrees with this characterization. The IP

address in this step does not translate into an extension number as disclosed in Chavous. The Examiner also stated that the step of encapsulating the physical address information within a PSAP message is disclosed in Chavous. The Applicant respectfully disagrees with this characterization. Nowhere in the cited passage or anywhere in Chavous does it disclose sending an encapsulated message.

In regards to Kelly, Kelly discloses a method and apparatus to enable packet switched networks and circuit switched networks to communication. Kelly, like Chavous discloses the use of a PBX. The Examiner stated that it would have been obvious to a person of ordinary skill in the art to modify Chavous to use IP telephony instead or in addition to circuit switched telephony.

In regards to Ansett, Ansett discloses the territorial determination of a remote computer location in a wide area network. Ansett merely discloses obtaining a geopolitical territory, e.g., a country, where a country is located (see col. 3, lines 23-25). Ansett does not teach or suggest the actual physical location, but rather a generalized location. Therefore, the combination of Chavous, Kelly and Ansett does not teach or suggest all the elements of the present invention.

In addition, the Applicant respectfully disagrees that the combination of the cited references is obvious. It is important to recognize that "[w]hen an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references." *WMS Gaming Inc. v. International Game Technology*, 51 USPQ 2d 1385, 1397 (Fed. Cir. 1999). See also *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1456 (Fed. Cir. 1999); *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

As reiterated and emphasized by the Federal Circuit, such a requirement is a powerful protection against impermissible hindsight reconstruction:

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. [citations omitted]. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability— the essence of hindsight...[citations omitted]." *In re Dembiczak*, 50 USPQ 2d 1614,1617 (Fed. Circ., 1999).

In this case, Chavous provides a method and system for determining the location of a PBX extension phone in a PBX system. Kelly provides the use of an IP telephone with a PBX. Likewise, Ansell provides a method of determining a generalized location of a remote computer. None of the references provides the determination of a physical location from an IP address, nor does each of the references provide a motivation for combining the references with each other. Therefore, the Applicant respectfully submits that the combination of Chavous, Kelly and Ansell is improper since a claimed invention can "not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention." *National Steel Car Ltd. v. Canadian Pacific Railway Ltd.*, 69 USPQ 2d 1641, 1654-55 (Fed. Cir. 2004), citing *Ecolchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ 2d 1065, (Fed. Cir. 2000). Indeed, the only teaching or suggestion that supports the combination of these references is found in the teaching of the present application. In short, this is a classic case of hindsight reconstruction in which the present patent application has been used as "a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

Claims 22-29 depend from claim 21 and recite further limitations in combination with the novel elements of claim 21. Claims 31-39 depend from claim 30 and recite further limitations in combination with the novel elements of claim 30. Therefore, the allowance of claims 21-39 is respectfully requested.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



By Sidney L. Weatherford
Registration No. 45,602

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Ericsson Inc.
6300 Legacy Drive, M/S EVR 1-C-11
Plano, Texas 75024

(972) 583-8656
sidney.weatherford@ericsson.com